



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,459	08/02/2007	Peter Habermeyer	635-46315X00	4231
20457 7590 05/28/2008 ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873				
EXAMINER STEWART, JASON-DENNIS NEILKEN				
ART UNIT 3738		PAPER NUMBER		
MAIL DATE 05/28/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/586,459

Applicant(s)

HABERMEYER ET AL.

Examiner

JASON-DENNIS STEWART

Art Unit

3738

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-8 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-8, and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

The following is a Final Office action in response to communications received on 03/06/08. Claims 3 and 13-16 have been cancelled. Claims 1, 5, 8, and 11 have been amended. Therefore, Claims 1, 4-8, and 10-12 are pending and addressed below.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by Guederian et al. 2004/0059424
3. Guederian discloses a method of fitting a shoulder prosthesis comprising fitting the attachment part on previously prepared bone with the use of projections 209 and 214, after which anchoring body is affixed to the bone by hollow screw 8 through a medial hole 206 in the positioning body (paragraphs 15 – 20). Guederian also discloses a collar 203 which serves to abut component 100. It should be noted that phrase "Method of fitting ..., ...attachment body within the bone" is in the preamble of the

method claim and do not provide any specific method steps and thus is given limited patentable weight.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4-7, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tornier 2003/0149485 in view of Guederian et al. 2004/0059424.

6. Regarding Claims 1 and 16, Tornier illustrates at least a two-piece humeral prosthesis with a joint head 1 and three part design attachment 2, 3, 4 with a disk-like portion having a medial hole 25 (fig. 1) making the attachment hollow. Tornier further illustrates a circular collar 23 around the medial hole. The phrase "to effect an at least cement-free anchoring attachment" is seen as an intended use limitation being that all structure is present in the prior art invention. Tornier, discloses a shank with grooves for attachment, however, Tornier does not disclose a screw for attachment.

Guederian illustrates a hollow screw 8, and at least a two part design for an attachment part (Fig. 4) of a prosthesis.

It would have been obvious to one of ordinary skill of the art to modify the device of Tornier with hollow screw of the Guederian because screws are a means for

attachment commonly known to a skilled artisan in manufacturing and in order to provide bone growth into the screw as taught by Guederian (paragraph 19).

7. Regarding Claims 4 and 12, Tornier illustrates a joint head with a nearly spherical surface and an opening with an angle α less than 180 degrees (Fig. 1).

8. Regarding Claim 5, Tornier illustrates a circular support surface 23 with a conical support edge that rests on support edge (fig. 5).

9. Regarding Claim 6, Tornier illustrates a hollow receiver 11 on the side opposite the nearly spherical surface (fig. 1).

10. Regarding Claim 7, Tornier illustrates a slightly conical receiver wall 12 and a slightly conical external collar surface 24 (fig. 3).

11. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guederian et al. 2004/0059424 in view of Tornier 2003/0149485.

12. Regarding Claims 10 and 11, Guederian discloses the invention as claimed and as discussed above. However, Guederian does not disclose a hollow receiver with a slightly conically shaped wall, a collar with a slightly conically shaped edge, and an external force used to fix the attachment body.

Tornier illustrates a slightly conical receiver wall 12 and a slightly conical external collar surface 24 (fig. 3) for the purpose of mating the joint head and the anchoring means as well as a force (E1) used to fix the parts of the prosthesis together.

It would have been obvious one of ordinary skill in the art at the time of the invention to modify the method of Guederian with the steps of Tornier in order to securely fix the femoral head to the anchoring means during surgery.

Response to Arguments

Applicant's arguments with respect to claims 1, 4-7, and 12 have been considered but are moot in view of the new ground(s) of rejection. Even still it should be noted that elements 2-4 make up the "attachment part" in the above Tornier reference. Also, even if Tornier did not disclose a multi-piece attachment design, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to make a multi-part design, since it has been held by the courts making an integral structure separable (e.g. in a plurality of pieces), if so is desired, would require only ordinary skill. *In re Dulberg*, 129 USPQ 348, 349 (CCPA 1961).

Regarding the Guederian reference, element 200 is the "positioning body" as it positions the screw via the circular bore 206.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON-DENNIS STEWART whose telephone number is (571)270-3080. The examiner can normally be reached on M-F (alt Fridays off) 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571)272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3738

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JS
/Jason-Dennis Stewart/
Examiner, Art Unit 3738

/Brian E Pellegrino/
Primary Examiner, Art Unit 3738